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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/566,102	01/26/2006	Rico Lampert	022862-1077-00	9574
23409 7590 05/27/2010 MICHAEL BEST & FRIEDRICH LLP 100 E WISCONSIN AVENUE Suite 3300 MILWAUKEE, WI 53202				
EXAMINER				
LUONG, VINH				
ART UNIT		PAPER NUMBER		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/566,102

Applicant(s)

LAMPERT ET AL.

Examiner

Vinh T. Luong

Art Unit

3656

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 May 2010.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-18 is/are pending in the application.
4a) Of the above claim(s) 3, 5 and 9-16 is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1, 4, 6-8, 17 and 18 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 26 January 2006 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

1. The amendment filed on May 7, 2010 has been entered.
2. Claims 3, 5, and 9-16 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on December 7, 2009.
3. The drawings are objected to because the drawings are not in compliance with 37 CFR 1.84. Please see Form PTO-948 attached to the restriction requirement on September 18, 2009.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. *The objection to the drawings will not be held in abeyance.*

4. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the claimed features, such as, the structure and the fixing dome fixed to the structure in claim 1; the motor vehicle body and the

fixing dome fixed to the motor vehicle body in claim 17 must be shown or the features canceled from the claims. No new matter should be entered.

5. The disclosure is objected to because of the informalities: (a) each part of the invention, *e.g.*, the structure in claim 1 and the motor vehicle body in claim 17 should be designated by a reference character. Please see MPEP 608.01(o) and (g); and (b) the specification should not use a variety of different terms, such as, “screw layouts” in ¶ 30 and “screw image” in ¶ 31 to designate the same thing. See MPEP 608.01(o). Appropriate correction is required.

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

7. Claim 18 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

New claim 18 recites: “the fixing dome (6, 7, 8, 9) is arranged such that the fixing dome (6, 7, 8, 9) is *slideable along a circumference (15) or an edge (16, 17) of a housing part.*” (Emphasis added). Applicant has not pointed out where the new claim 18 is supported, nor does there appear to be a written description of the claim limitations “the fixing dome (6, 7, 8, 9) is *slideable along a circumference (15) or an edge (16, 17) of a housing part*” in the application as filed. See MPEP §§ 2163.01, 2163.04, and 2163.06.

8. Claim 18 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly location out and distinctly claim the subject matter which applicant regards as the invention.

It is unclear whether a confusing variety of terms, such as, “a housing part” and “at least one housing part” in claim 18/1 refers to the same or different things. Please see MPEP 608.01(o) and double inclusion in MPEP 2173.05(o).

The term “*slidable*” in new claim 18 is vague and indefinite in the sense that things which may be done are not required to be done. For example, the fixing dome (6, 7, 8, 9) is *slideable* but is not required structurally to be slid *along a circumference (15) or an edge (16, 17) of a housing part*. See “crimpable” in *In re Collier*, 158 USPQ 266 (CCPA 1968), “discardable” in *Mathis v. Hydro Air Industries*, 1 USPQ2d 1513, 1527 (D.C. Calif. 1986), “removable” in *In re Burke Inc.*, 22 USPQ2d 1368, 1372 (D.C. Calif. 1992), and “comparable” in *Ex parte Anderson*, 21 USPQ2d 1241, 1249 (BPAI 1992).

9. Claims 1, 6-8, and 17, and claim 18, as best understood, are rejected under 35 U.S.C. 102(b) as being anticipated by Blankenburg et al. (US 4,216,624).

Claims 1 and 17

Blankenburg teaches a gearbox drive unit 1, especially for adjusting movable parts in a motor vehicle, comprising at least one housing part 15 and at least one fixing dome (at 36 or 42 in FIG. 2), which is used to secure the gearbox drive unit 1, characterized in that the housing part 15 comprises a first connection location (at 36) and at least one other second connection location (at 42), whereon the fixing dome (at 36 or 42) is configured to be placed, and that the fixing dome (at 36 or 42) is connected to the housing part 15 at either the first connection location (36) *or* at the second connection location (42) according to a screw layout (at 42 in FIGS. 2-4, *id.* 3:25-35) for fixation of the gearbox drive unit 1, characterized in that the fixing dome (at 36 or 42) includes a projection 37 (FIG. 6), which engages in a groove 39 in the housing part 15 of the

gearbox drive unit 1 in order to create the connection between the fixing dome (at 36 or 42, *id.* 5:59-6:6) and the housing part 15, characterized in that the fixing dome (at 36 or 42) is fixed to a structure, *i.e.*, a motor vehicle body 12 (FIG. 1).

Claim 1 and other claims below are anticipated by Blankenburg because Blankenburg teaches each and every positively claimed element. On the one hand, the intended use recitation, such as, “*used to secure the gearbox drive unit*” in line 3 of claim 1 is not accorded patentable weight. It is well settled that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See *In re Casey*, 152 USPQ 235 (CCPA 1967); *In re Otto*, 136 USPQ 458, 459 (CCPA 1963); and *In re Schreiber*, 44 USPQ2d 1429 (Fed. Cir. 1997). On the other hand, Blankenburg’s fixing domes (at 36 or 42) are used to *operatively* connect the gearbox drive unit 1 to the structure, such as, the motor vehicle body 12 as seen in FIG. 1. As noted, claim 1 does not preclude the fixing dome used to *operatively* secure the gearbox drive unit to the structure, *a fortiori*, Blankenburg’s fixing domes “read on” the claimed fixing dome. It is well settled that anticipation law requires distinction be made between invention described or taught and invention claimed. It does not require that the reference “teach” what subject patent application teaches, it is only necessary that the claim under attack, as construed by the Court, “*read on*” something disclosed in the reference, *i.e.*, all limitations of the claim are found in reference, or are “*fully met*” by it. *Kalman v. Kimberly Clark Corp.*, 218 USPQ 781, 789 (CAFC 1983). See also “operatively connected” in *Innova/Pure Water Inc. v. Safari Water Filtration Systems, Inc.*, 72 USPQ2d 1001 (Fed. Cir. 2004).

Claim 6

The gearbox drive unit 1 includes several fixing domes (at 36 or 42 in FIG. 2) of the same type. The first and second connection locations are provided on the housing part 15 of the gearbox drive unit 1, whereon the fixing domes (at 36 or 42) are configured to be placed. The fixing domes (at 36 or 42) are connected to the housing part 15 at selected connection locations (FIG. 2), whereby the selected locations are selected according to the screw layout (at 42) for fixation of the gearbox drive unit 1.

Claim 7

At least one other fixing dome (at 36 or 42) is provided and that the fixing dome (at 36) and the other fixing dome (at 42) have a common base body 16 so that the fixing dome (at 36) and the other fixing dome (at 42) are configured to be connected jointly to the housing part 15.

Claim 8

The housing part 15 has, at least in sections, a circular ring-shaped section (at 15 in FIGS. 4 and 5), that the common base body 16 of the fixing dome (at 36) and of the other fixing dome (at 42) partially surrounds the circular ring-shaped section (FIG. 2) and are configured to be *operatively* connected at the first and second connection locations (at 36 and 42) with the circular ring-shaped section (FIGS. 2-5).

Claim 18

The dome (at 36 or 42) is arranged such that the dome (at 36 or 42) is capable of being slidable (by, *e.g.*, unfastening their connecting elements, then, sliding the dome) along an edge of the housing part 15 as seen in, *e.g.*, FIG. 6. In addition, please note that the functional limitations of a claim may not be given patentable weight where those limitations are inherent

in a prior art reference. *In re Schreiber*, 44 USPQ2d 1429 (CAFC 1997). Moreover, as a matter of linguistic precision, the permissive language “*slidable*” does not narrow claim, since it can be omitted. See *In re Johnston*, 77 USPQ2d 1788, 1790 (Fed. Cir. 2006); *In re Collier*; *Mathis v. Hydro Air Industries*; *In re Burke Inc.*; and *Ex parte Anderson*, *supra*.

10. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Blankenburg.

Blankenburg teaches: “The two parts of the casing can be firmly connected together by *conventional detachable or permanent connecting elements*, for example by screws or rivets.” (Emphasis added). (*Ibid.* 3:25-35)

It is common knowledge in the art to substitute Blankenburg’s connecting elements, such as, screws or rivets by the conventional permanent connecting elements, such as, welding in order to connect Hager’s fixing dome to Hager’s housing part. The use of welding as a connecting element is notoriously well known. For example, see c. 3, ll. 49-57 in US 6,515,399 issued to Lauf et al., and Description of Prior Art in US 5,045,737 issued to Yamauchi.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to use welding as the connecting element in order to connect Hager’s fixing dome to Hager’s housing part as taught or suggested by common knowledge in the art. The modification of Hager’s gearbox drive unit by using the welding as the connecting element would not have been uniquely challenging to a person of ordinary skill in the art because it is no more than “the simple substitution of one known element for another or the mere application of a known technique to a piece of prior art ready for the improvement” *KSR Int’l. Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007) and it “does no more than yield predictable results.” *KSR* at 1739.

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Klingler et al. (groove 22), Ochiai (groove 28), Oh et al. (FIG. 9), Tsergas (connection locations 172), Gievers et al. (screw layout 8), and Yamashita (screw layout 56).
12. Applicant's arguments filed May 7, 2010 have been fully considered but they are not persuasive.

DRAWINGS

Applicant did not address the objection to the drawings set forth in Form PTO-948 as required under 37 CFR 1.111(b). (Amend. p. 8). Therefore, the Examiner respectfully reiterates this ground of objection. Please note that MPEP 608.02(b) states: "A request to hold objections to the drawings in abeyance will not be considered a *bona fide* attempt to advance the application to final action (37 CFR 1.135(c))." For examples of proper drawings, please see the "Guide for the Preparation of Patent Drawings" available from the USPTO web site at www.uspto.gov.

35 USC 112, ¶¶ 1st & 2nd

The previous rejections are withdrawn in view of Applicant's amendments. However, the amendments necessitate new grounds of rejections as set forth above.

35 USC 102(b)

The rejections based on Hager (DE 10019512) are withdrawn in view of Applicant's amendments to the claims and specification. Applicant's arguments with respect to claims 1, 4, 6-8, 17, and 18 have been considered but are moot in view of the new ground(s) of rejection.

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vinh T. Luong whose telephone number is 571-272-7109. The examiner can normally be reached on Monday, Tuesday, Thursday, and Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Ridley can be reached on 571-272-6917. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Vinh T Luong/
Primary Examiner, Art Unit 3656